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| 26418 | 7590 | 09/10/2004 | EXAMINER | |
| REED SMITH, LLP ATTN: PATENT RECORDS DEPARTMENT 599 LEXINGTON AVENUE, 29TH FLOOR NEW YORK, NY 10022-7650 | | | FAULK, DEVONA E | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2644 | |

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/942,522

Applicant(s)

BEBENROTH, WOLF-DIETRICH

Examiner

Devona E. Faulk

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6 and 8-13 is/are pending in the application.
4a) Of the above claim(s) 2 and 7 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1,3-6,8-13 is/are rejected.
7) ☒ Claim(s) 4 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 6/23/2004 with respect to claims 1, 3, 5-7, 11 have been considered but are moot in view of the new ground(s) of rejection.
2. Applicant's arguments filed 6/23/2004 with respect to claim 4 have been considered and are persuasive.

The applicant asserts, on page 9, that the examiner's argument impermissibly adds an element or structure, namely a clutch, that is not disclosed by Neuman or Taylor. The examiner agrees. The rejection of claim 4 is withdrawn. Claim 4 will be an objected claim because the examiner could not find prior art to read on the claim language.

Specification

3. The disclosure is objected to because of the following informalities:

On page 5, lines 23 and 26, the term "acoustic transducers" is referenced by two different numbers. First as "6" on line 23, and then as "4" on line 26, corresponds to two side pieces, but on page 5 appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. **Claims 1,3-6,8-10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Neuman et al. (U.S. Patent 5,642,426) in view of Myers et al. (U.S. Patent 5,751,825).

Regarding **claim 1**, Neuman discloses an integral radio and infrared assistive listening device having a circuit housing having an electrical circuit for a headset, such as for a chin loop headset (Figure 1; column 3, lines 42-56); and wherein said cover is transmissive for infrared rays (column 3, lines 51-55; column 5, lines 51-57). Although he teaches also on a volume control, he fails to disclose wherein rotating said cover actuates said electrical circuit for controlling volume. However the concept of rotating a cover to actuate a circuit and control volume was well known in the art at the time of filing as taught by Myers. Myers discloses a headphone comprising an axis member mounted in said housing and a front cover rotatable about said axis member wherein rotating said cover actuates said electrically circuit for controlling volume and power (Figure 1; column 3, lines 44-59). Thus it would have been obvious to one of ordinary skill in the art at the time of the invention to use Myers's concept of a rotating cover to actuate a circuit to control volume in order to be able to adjust power and volume.

Claim 3 claims the circuit housing of claim 1 wherein said cover has a scale, which cooperates with a marking on the housing. As stated above apropos of claim 1, the combination of Neuman and Myers meets all elements of claim 3. Therefore, the combination meets s all elements of claim 3 with the exception of the cover having a scale, which cooperates with a marking on the housing. Myers discloses the claimed matter (Figure 1; column 3, lines 44-58). All elements of claim 3 are comprehended by claim 8. Claim 10 is rejected for reasons given above apropos of claim 1.

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Claim 5 claims the circuit housing of claim 1 wherein said housing is circular-cylindrical. As stated above apropos of claim 1, the combination of Neuman and Myers meets all elements of claim 1. Therefore, the combination meets all elements of claim 5 with the exception of the housing having a circular-cylindrical shape. The shape of Neuman's housing is showed in Figure 5. Myers discloses a circular shaped housing. All elements of claim 5 are comprehended by claim 1. Claim 5 is rejected for reasons given above apropos of claim 1.

Claim 6 claims the circuit housing of claim 1 wherein said cover is circular. As stated above apropos of claim 1, the combination of Neuman and Myers meets all elements of claim 1. Therefore, the combination meets all elements of claim 5 with the exception of the cover having a circular shape. Myers discloses a circular shaped cover. All elements of claim 5 are comprehended by claim 1. Claim 5 is rejected for reasons given above apropos of claim 1.

Claim 8 claims the circuit housing of claim 1, wherein provided on the outside of the housing is at least one further actuating element of the circuit. As stated above apropos of claim 1, the combination of Neuman and Myers meets all elements of that claim. Therefore, the combination meets all elements of claim 8 with the exception of at least one further actuating element of the circuit provided on the outside of the housing. Neuman further teaches of a selector switch (10, Figure 5) and an on/off switch (20, Figure 5), and of an IR receiver (8, Figure 5), which inherently would be disposed on the outside of the housing. All elements of claim 8 are comprehended by claim 1. Claim 2 is rejected for reasons given above apropos of claim 1.

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Claim 9 claims the circuit housing of claim 8, wherein said further actuating element is a button. As stated above apropos of claim 8, the combination of Neuman and Myers meets all elements of that claim. Therefore, the combination meets all elements of claim 9 with the exception of the actuating element being a button. Neuman's Figure 5 indicates that both the selector switch (10) and the on/off switch (20) are buttons. All elements of claim 9 are comprehended by claim 8. Claim 9 is rejected for reasons given above apropos of claim 8.

Claim 10 claims the circuit housing of claim 8 wherein said actuating element is arranged in a recess at the outside of the housing. As stated above apropos of claim 8, the combination of Neuman and Such meets all elements of that claim. Therefore, the combination meets all elements of claim 10 with the exception that the actuating element is arranged in a recess at the outside of the housing. Neuman's Figure 5 indicates that both the selector switch (10) and the on/off switch (20) are buttons and it is obvious from the figure that they are arranged in a recess at the outside of the housing. Additionally, Myers discloses an actuating element (34) arranged in a recess as claimed. All elements of claim 10 are comprehended by claim 8. Claim 10 is rejected for reasons given above apropos of claim 8.

6. **Claims 11 and 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Neuman et al. (U.S. Patent 5,642,426) in view of Myers et al. (U.S. Patent 5,751,825) in further view of Such (U.S. Patent 5,457,751).

Claim 11 claims the circuit housing of claim 8 wherein said further actuating element is arranged at the rear side of the housing, which is in opposite relationship to the cover. As stated above apropos of claim 8, the combination of Neuman and Myers meets

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all elements of that claim. Therefore, the combination meets all elements of claim 11 with the exception of the further actuating element being arranged at the rear side of the housing which is in opposite relationship to the cover. Such discloses an actuating element on the side (52, Figure 5). It is therefore obvious that an actuating element can be placed in the rear if desired. Thus it would have been obvious to one of ordinary skill in the art at the time of the invention to place at least one other actuating element on the rear side of the housing for the benefit of having a multifunctional headset.

Claim 12 claims the circuit housing of claim 11, wherein said rear side further comprises a recess accommodating said further actuating element. As stated above apropos of claim 11, the combination of Neuman and Myers meets all elements of that claim. Therefore, the combination meets all elements of claim 12 with the exception of the claimed matter. Neuman's Figure 5 indicates that both the selector switch (10) and the on/off switch (20) are buttons and it is obvious from the figure that they are arranged in a recess at the outside of the housing. Additionally, Myers discloses an actuating element (34) arranged in a recess as claimed. All elements of claim 12 are comprehended by claim 11. Claim 11 is rejected for reasons given above apropos of claim 12.

7. **Claim 13** is rejected under 35 U.S.C. 103(a) as being unpatentable over Neuman et al. (U.S. Patent 5,642,426) in view of Myers et al. (U.S. Patent 5,751,825) in further view of Dascal et al. (U.S. Patent 3,902,120).

Claim 13 claims the circuit housing of claim 1 further comprising a socket for accepting a stereo jack plug. As stated above apropos of claim 1, the combination of Neuman and Myers meets all elements of that claim. Therefore, the combination meets all elements of claim 13 with the exception of the claimed matter. Dascal discloses a

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circuit housing (32) with a stereo jack or socket (42, Figures 3, 4). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to use Dascal's concept of a circuit housing having a stereo socket in order to provide an external stereo signal.

Claim Objections

8. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 3,781,492 to Cragg et al. discloses a headset

U.S. Patent 4,277,654 to Penning discloses a stethoscopic headphone set.

U.S. Patent 3,671,685 to McCabe discloses an electro-acoustic headset with ratchet.

U.S. Patent Application US 2002/0186858 to Masuda et al. discloses loop-down and loop-around headsets.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Devona E. Faulk whose telephone number is 703-305-4359. The examiner can normally be reached on 8 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester W. Isen can be reached on 703-305-4386. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

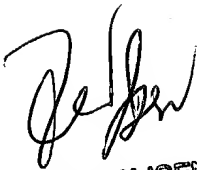
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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FORESTER W. ISEN
SUPERVISORY PATENT EXAMINER